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29053	7590	01/17/2006	EXAMINER	
DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.			POKRZYWA, JOSEPH R	
2200 ROSS AVENUE			ART UNIT	
SUITE 2800			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/953,477	Applicant(s) KARA ET AL.	
	Examiner Joseph R. Pokrzywa	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-74 and 90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-74 and 90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 10/3/05, and has been entered and made of record. Currently, **claims 57-74, and 90** are pending.

Response to Arguments

2. Applicant's arguments filed 10/3/05 have been fully considered but they are not persuasive.

3. In response to applicant's arguments regarding the rejection of claim 57, which was cited in the Office action dated 7/1/05 under 35 U.S.C. 102(e) as being anticipated by Kaufeld *et al.* (U.S. Patent Number 5,859,967), whereby applicant argues on pages 5 and 6 that Kaufeld fails to teach of a reproducing circuit at the intermediate station that reproduces the transmitted information in human readable form and that also produces an indicia of payment authorizing delivery of the human readable information to the selected location. Kaufeld teaches of an intermediate station, being the computer 26 seen in Figs. 1 and 2, whereby the computer 26 includes a fax board 66 or the printer 60, which is interpreted as a reproducing circuit adapted to reproduce received information in human readable form. Further, Kaufeld teaches that the fax board 66 or the printer 60 can be used to generate stamps, which will later be used for a subsequent transmission of the received data, as read in column 5, lines 11-13, and column 6, lines 7-11. These generated stamps are used as payment methods and authorize delivery of the human readable information to the selected location, as read in column 5, lines 6-57.

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Therefore, as the claims are currently written, Kaufeld can be interpreted as teaching of having a reproducing circuit at the intermediate station that reproduces the transmitted information in human readable form and that also produces an indicia of payment authorizing delivery of the human readable information to the selected location.

4. Additionally, applicant argues on page 6 that Kaufeld also fails to teach of a converter circuit (at the intermediate station adapted to convert the transmission to electronic form if the transmitted information is not initially in electronic form. The examiner notes that the phrase “in electronic form” is being interpreted as being a in a format of “in facsimile form”. With this, Kaufeld can be seen as teaching of receiving transmitted information (column 3, line 31-column 4, line 16) and converting the transmission to electronic form (interpreted as a facsimile form) if the transmitted information is not initially in electronic form, as read in column 3, line 31-column 4, line 28, whereby the received transmitted information is an electronic mail that is converted into a facsimile. The received electronic mail is not in a facsimile format, thus can be seen as being “not initially in electronic form”. Thus, Kaufeld can be seen as teaching of a converter circuit adapted to electronically receive the transmitted information and to convert the transmission to electronic form if the transmitted information is not initially in electronic form, as currently required in the claim language.

5. Therefore, the rejection of **claim 57**, as cited in the Office action dated 7/1/05, as being anticipated by Kaufeld is maintained and repeated in this Office action.

6. In response to applicant’s arguments regarding the rejection of claims 58-60, whereby applicant argues on page 7 that Kaufeld fails to teach if intermediate location is selected according to proximity to selected location. As read in column 6, lines 24-55, the address of

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faxsav.com, being the intermediate location, can be any suitable domain, thus including a selection according to proximity to the selected location. For instance, if the operator wishes to send a message to a recipient in Japan, the selected domain would be “.jp”, as the subsequent facsimile transmission would then be a local telephone call. Further, as read in column 4, lines 7-22, one desire for implementing Kaufeld’s system is that “long distance telephone lines may be reduced or eliminated”. Thus, Kaufeld can be interpreted as teaching the limitations found in claims 58-60, as the intermediate location can be selected based on the proximity to the selected location or the transmitting location.

7. In response to applicant’s arguments regarding the rejection of claims 61 and 62, whereby applicant argues on pages 8 and 9 that Kaufeld fails to teach of circuitry adapted to accept electronic documents communicated utilizing different communication protocols. As read in column 3, line 10-column 4, line 28, Kaufeld teaches that the “local computer 30 executes any type of communication or email program”. Further, Kaufeld teaches in column 4, lines 41-46, that facsimile data can be transmitted and received. Additionally, in column 4, lines 56-column 7, line 5, Kaufeld teaches of using a MIME communication protocol, and in column 10, lines 41-53, teaches of using a SMIME communication protocol. Thus, Kaufeld can be interpreted as teaching of accepting electronic documents communicated utilizing different communication protocols, as required in claim 61, as well as teaching of using a standardized electronic mail protocol, a special purpose mail communication protocol, and a standardized facsimile protocol, as required in claim 62.

8. In response to applicant’s arguments regarding the rejection of claims 64 and 71, whereby applicant argues on pages 9 and 10 that Kaufeld fails to teach of circuitry adapted to

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verify the accuracy of the delivery address information. As seen in Fig. 3, Kaufeld teaches in step 104 that input information is verified in step 104, and read in column 5, lines 14-25.

Further, Kaufeld additionally teaches in column 7, lines 13-34 that “The “To” line contains the phone number of the receiving device, line 5 indicates that the message is from the address of the person sending the email”, as seen in Fig. 6. Because these numbers are generated by the computer 26 from the addresses seen in Fig. 4, and data is transmitted back to the sending email address, as seen in Fig. 7, so as to verify the delivery of the message. Thus, the circuitry within the computer 26 can be interpreted as including circuitry adapted to verify the accuracy of the delivery address information.

9. In response to applicant’s arguments regarding the rejection of claim 67, whereby applicant argues on page 9 that Kaufeld fails to teach of acknowledgment circuitry adapted to transmit the acknowledgment to the transmitting location, wherein the last mentioned portion of the acknowledgment circuit is inactive until the funding means is confirmed. As seen in Fig. 8C, in step 230, an email is transmitted back to the sender indicating successful transmission, and read in column 8, line 57-column 9, line 3. This successful transmission message is generated in the acknowledgment circuit. Continuing, this successful acknowledgment is not generated until funding means is confirmed, as seen in step 180 and 182 in Fig. 8A, and read in column 7, line 58-column 8, line 35. Thus, Kaufeld can be interpreted as teaching of acknowledgment circuitry adapted to transmit the acknowledgment to the transmitting location, wherein the last mentioned portion of the acknowledgment circuit is inactive until the funding means is confirmed.

10. In response to applicant’s arguments regarding the rejection of claim 69, whereby applicant argues on pages 9 and 10 that Kaufeld fails to teach if the value is deducted from a

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credit stored at the transmitting location. As read in column 5, lines 8-13, "The user must enter billing information such as credit card information or checking account information or any other suitable billing information". With this, Kaufeld can be interpreted as teaching of deducting a value from a credit stored at the transmitting location, as a value of a checking account, which is stored at the transmitting location, is inherently deducted after being billed. Thus, the Kaufeld can be interpreted as teaching the limitation.

11. In response to applicant's arguments regarding the rejection of claim 72, whereby applicant argues on page 10 that Kaufeld fails to teach if the time is provided by a secure time piece disposed at the transmitting location. Kaufeld's clock/timer 68, within the transmitting location would inherently be a secure timepiece, as it is secured in the computer. Therefore, Kaufeld can be interpreted as teaching of the time being provided by a secure time piece disposed at the transmitting location.

12. In response to applicant's arguments regarding the rejection of claim 73, whereby applicant argues on pages 10 and 11 that Kaufeld fails to teach if the ancillary information includes specific delivery information regarding the delivery of the human readable information, indicating selection of at least one delivery option of a plurality of delivery options available for delivery of the transmitted information. As read in column 10, lines 54-60, a delivery option of transmitting one email to a plurality of recipients is described, whereby ancillary information, being the single email message having a pre-registered group as a recipient, is received. Thus, Kaufeld can be seen as teaching that one delivery option is available for delivery of the transmitted information, with the delivery option being in ancillary information.

13. In response to applicant's arguments regarding the rejection of claim 90, whereby applicant argues on page 11 that Kaufeld fails to teach if the intermediate station comprises an acknowledgment circuit adapted to produce an acknowledgment of receipt of the transmitted information. As seen in Fig. 7, lines 8 and 9, Kaufeld describes "Your email received at May 21, 10:51:34 from email address" Thus, this acknowledgment, which is sent back to the sender, effectively produces an acknowledgment of the receipt of the transmitted information.

14. Therefore, the rejection of **claims 57**, as well as dependent **claims 58-74 and 90**, as cited in the Office action dated 7/1/05, as being anticipated by Kaufeld is maintained and repeated in this Office action.

Claim Rejections - 35 USC § 102

15. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

16. **Claims 57-74 and 90** are rejected under 35 U.S.C. 102(e) as being anticipated by Kaufeld *et al.* (U.S. Patent Number 5,859,967, cited in the Office action dated 7/1/05).

Regarding **claim 57**, Kaufeld discloses a system for delivering information to a selected location from a transmitting location (see abstract, Fig. 1, and column 3, lines 10-65), the system comprising a transmission station operable at the transmitting location (local computer 30) and adapted to transmit the information to an intermediate location (column 3, lines 10-46), and an intermediate station operable at the intermediate location (computer 26) and adapted to receive the information transmitted by the transmitting station (column 3, line 31-column 4, line 28), wherein the intermediate station (computer 26) comprises a converter circuit (microprocessor 52,

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seen in Fig. 2) adapted to electronically receive the transmitted information (column 3, line 31-column 4, line 16) and to convert the transmission to electronic form (interpreted as a facsimile form) if the transmitted information is not initially in electronic form (column 3, line 31-column 4, line 28), and a reproducing circuit (being either the fax board 66 or the printer 60) adapted to reproduce the information in human readable form (column 3, line 31-column 4, line 28, and column 11, lines 39-62), wherein the reproducing circuit also produces an indicia of payment authorizing delivery of the human readable information to the selected location (column 3, lines 31-46, and column 5, lines 1-57).

Regarding *claim 58*, Kaufeld discloses the system discussed above in claim 57, and further teaches of the intermediate location being selected according to proximity to the selected location (column 6, lines 24-55, whereby the address of faxesav.com, being the intermediate location, can be any suitable domain, thereby including selection according to proximity to the selected location).

Regarding *claim 59*, Kaufeld discloses the system discussed above in claim 58, and further teaches of the intermediate location selection is accomplished automatically by the transmitting location through reference to address information with respect to the selected location (column 6, lines 24-55).

Regarding *claim 60*, Kaufeld discloses the system discussed above in claim 57, and further teaches of the intermediate location is selected according to proximity to the transmitting location (column 6, lines 24-55, whereby the address of faxesav.com, being the intermediate location can be any suitable domain, thereby including selection according to proximity to the transmitting location).

Regarding *claim 61*, Kaufeld discloses the system discussed above in claim 57, and further teaches of the converter circuit comprises circuitry adapted to accept electronic documents communicated utilizing different communication protocols (column 3, line 10-column 4, line 28).

Regarding *claim 62*, Kaufeld discloses the system discussed above in claim 61, and further teaches of the different communication protocols include at least two protocols selected from the group consisting of a standardized electronic mail communication protocol (column 3, line 10-column 4, line 28), a special purpose mail communication protocol, a standardized facsimile protocol (column 3, line 10-column 4, line 28), a standardized character based protocol, and a standardized packet based protocol.

Regarding *claim 63*, Kaufeld discloses the system discussed above in claim 57, and further teaches of the converter circuit comprising circuitry adapted to determine delivery address information with respect to the selected location from information contained within the transmitted information (column 6, lines 24-55, and column 7, lines 13-34, see Figs. 4-7).

Regarding *claim 64*, Kaufeld discloses the system discussed above in claim 63, and further teaches of the converter circuit comprising circuitry adapted to verify the accuracy of the delivery address information (column 6, lines 24-55, and column 7, lines 13-34, see Figs. 4-7).

Regarding *claim 65*, Kaufeld discloses the system discussed above in claim 57, and further teaches of a means for including ancillary information with the transmitted information (column 6, lines 24-55), wherein the ancillary information being suitable for use by the receiving means in delivery of the transmitted information to the selected location (column 6, lines 24-55, and column 7, line 35-column 8, line 35).

Regarding **claim 66**, Kaufeld discloses the system discussed above in claim 65, and further teaches of the ancillary information comprising means for funding delivery of the transmitted information (column 7, line 58-column 8, line 5).

Regarding **claim 67**, Kaufeld discloses the system discussed above in claim 66, and further teaches that the intermediate station further comprises an acknowledgment circuit adapted to produce an acknowledgment of receipt of the transmitted information (see Fig. 7, column 7, lines 25-34), and wherein the acknowledgment circuitry is further adapted to transmit the acknowledgment to the transmitting location (column 7, lines 25-34, and column 8, line 57-column 9, line 21), wherein the last mentioned portion of the acknowledgment circuit is inactive until the funding means is confirmed (column 7, line 58-column 8, line 35, and column 8, line 57-column 9, line 21).

Regarding **claim 68**, Kaufeld discloses the system discussed above in claim 66, and further teaches that the funding means includes at least a value data packet (column 5, line 1-column 6, line 23).

Regarding **claim 69**, Kaufeld discloses the system discussed above in claim 68, and further teaches that the value is deducted from a credit stored at the transmitting location (column 5, lines 1-57).

Regarding **claim 70**, Kaufeld discloses the system discussed above in claim 65, and further teaches of the ancillary information includes a delivery address of the selected location (column 6, lines 24-55, see Figs. 4-6).

Regarding *claim 71*, Kaufeld discloses the system discussed above in claim 70, and further teaches of the converter circuit comprises a means for verifying the accuracy of the delivery address information (column 6, lines 24-55, and column 7, lines 13-34, see Figs. 4-7).

Regarding *claim 72*, Kaufeld discloses the system discussed above in claim 65, and further teaches of the ancillary information includes a time of transmission of the document by the transmitting means (see Figs. 4-7), wherein the time being provided by a secure time piece disposed at the transmitting location (column 4, lines 41-46).

Regarding *claim 73*, Kaufeld discloses the system discussed above in claim 65, and further teaches of the ancillary information includes specific delivery information regarding the delivery of the human readable information (see Figs. 4-6, column 6, line 24-column 7, line 25, and column 10, line 54-column 11, line 62), indicating selection of at least one delivery option of a plurality of delivery options available for delivery of the transmitted information (column 10, line 54-column 11, line 62).

Regarding *claim 74*, Kaufeld discloses the system discussed above in claim 57, and further teaches of the reproducing circuit is operable at least in part with corresponding circuitry disposed at the selected location (column 8, line 48-column 9, line 21).

Regarding *claim 90*, Kaufeld discloses the system discussed above in claim 57, and further teaches of the intermediate station further comprising an acknowledgment circuit adapted to produce an acknowledgment of receipt of the transmitted information (see Fig. 7, column 7, lines 25-34, and column 8, line 57-column 9, line 21).

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622



jrp